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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,700	12/21/2001	Richard Hatch	1076.41036X00	6915
20457	7590	04/22/2004	EXAMINER	
ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-9889			DEAN, RAYMOND S	
			ART UNIT	PAPER NUMBER
			2684	

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/023,700

Applicant(s)

HATCH ET AL.

Examiner

Raymond S Dean

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 - 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Drawings*

1. Figures 3A and 3B should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. The applicant states "the front face of a conventional mobile telephone" on page 7 line 30 of the specification. The fact that it is "conventional" means that it is prior art. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: There is a missing reference number 31 in Figure 3B for the displayed list of entries. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

Art Unit: 2684

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 – 2, 9 – 10, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Sharma (US 2002/0151334 A1).

Regarding Claim 1, Sharma teaches an electronic device comprising a memory for storing a plurality of user selectable items (Figure 3, Section 0021 lines 8 – 11, the user selectable items are the contacts in the phone book) and a controller operable to order said items according to the frequency of selection of each item (Section 0019, Section 0021 lines 4 – 7, the software is the control program which resides on the controller).

Regarding Claim 2, Sharma teaches all of the claimed limitations recited in Claim 1. Sharma further teaches a mobile telecommunications device (Figure 1), a list of contacts (Figure 3).

Regarding Claim 9, Sharma teaches a method of handling a plurality of user selectable items stored in a memory of an electronic device (Figure 3, Section 0021 lines 8 – 11, the user selectable items are the contacts in the phone book), the method including the step of ordering items according to the frequency of selection of each item (Section 0019).

Regarding Claim 10, Sharma teaches all of the claimed limitations recited in Claim 9. Sharma further teaches a mobile telecommunications device (Figure 1), a list of contacts (Figure 3).

Regarding Claim 12, Sharma teaches a computer including a memory (Section 0021 lines 4 – 7, the processor is the computer) and a controller (Section 0021 lines 2-3), the memory storing a program executable by the controller to carry out the method of handling a plurality of user selectable items stored in the memory (Figure 3, Section 0019, Section 0021 lines 8 – 11, the user selectable items are the contacts in the phone book), the method including the step of selecting items from the plurality of selectable items in order according to the frequency of selection of each item (Section 0019).

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Schroeder et al. (5,797,098).

Regarding Claim 15, Schroeder teaches a predictive text-input means for text message entry on a mobile communications device (Figure 4, Column 6 lines 17 – 41), the predictive text input means presents, in response to a given text entry, one or more word predictions from a dictionary of words used by the predictive text input means (Figure 4, Column 6 lines 17 – 41), the predictive text input means comprising a counter that monitors the frequency of selections of words used from the dictionary (Column 7 lines 37 – 47) and provides an output based on the monitored frequency of selection

(Column 7 lines 37 – 47, the words are indexed based on their frequency), which output is used to modify the order of the predicted words presented in respect of the given text-entry (Column 7 lines 37 – 47, the words are indexed based on their frequency).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3, 11, and 13 - 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sharma (US 2002/0151334 A1) in view of Schroeder et al. (5,797,098).

Regarding Claim 3, Sharma teaches all of the claimed limitations recited in Claim

1. Sharma further teaches a mobile telecommunications device (Figure 1).

Sharma does not teach a dictionary of words, predicting and selecting a word stored in the dictionary in response to a text message entry, initially predicting and selecting the word most frequently selected by the user when more than one word fits a prediction.

Schroeder teaches a dictionary of words (Column 6 lines 30 – 31), predicting and selecting a word stored in the dictionary in response to a text message entry (Figure 4, Column 6 lines 17 – 41), initially predicting and selecting the word most frequently

selected by the user when more than one word fits a prediction (Figure 4, Column 6 lines 17 – 41).

Sharma and Schroeder both teach a hand held wireless phone with a limited keyboard for data entry thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the prediction and selection method taught above by Schroeder in the wireless phone of Sharma for the purpose of providing a hand held wireless phone that offers user friendly features that are easy to use despite the space limitations of said keyboard.

Regarding Claim 11, Sharma teaches all of the claimed limitations recited in Claim 9. Sharma further teaches a mobile telecommunications device (Figure 1).

Sharma does not teach a dictionary of words, predicting and selecting a word stored in the dictionary in response to a text message entry, predicting and selecting the word most frequently selected by the user when more than one word fits a prediction.

Schroeder teaches a dictionary of words (Column 6 lines 30 – 31), predicting and selecting a word stored in the dictionary in response to a text message entry (Figure 4, Column 6 lines 17 – 41), predicting and selecting the word most frequently selected by the user when more than one word fits a prediction (Figure 4, Column 6 lines 17 – 41).

Sharma and Schroeder both teach a hand held wireless phone with a limited keyboard for data entry thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the prediction and selection method taught above by Schroeder in the wireless phone of Sharma for the purpose of providing a

hand held wireless phone that offers user friendly features that are easy to use despite the space limitations of said keyboard.

Regarding Claim 13, Sharma teaches a program run on a computer (Section 0021 lines 4 – 7, the processor is the computer).

Sharma does not teach a method of predicting and selecting a word stored in the dictionary in response to a text message entry by the user and initially predicting and selecting the word most frequently selected by the user when more than one word fits a prediction.

Schroeder teaches predicting and selecting a word stored in the dictionary in response to a text message entry (Figure 4, Column 6 lines 17 – 41), initially predicting and selecting the word most frequently selected by the user when more than one word fits a prediction (Figure 4, Column 6 lines 17 – 41).

Sharma and Schroeder both teach a hand held wireless phone with a limited keyboard for data entry thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the prediction and selection method taught above by Schroeder in the wireless phone of Sharma for the purpose of providing a hand held wireless phone that offers user friendly features that are easy to use despite the space limitations of said keyboard.

Regarding Claim 14, Sharma in view of Schroeder teaches all of the claimed limitations recited in Claim 13. Sharma further teaches a computer readable medium (Section 0021 lines 8 – 10, the memory that stores the control program is the computer readable medium).



8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sharma (US 2002/0151334 A1) in view of Sauer et al. (US 2003/0078033 A1).

Regarding Claim 4, Sharma teaches all of the claimed limitations recited in Claim

1. Sharma further teaches a mobile telecommunications device (Figure 1).

Sharma does not teach a list of SMS templates.

Sauer teaches a list of SMS templates (Figure 3, Section 0020, there are a plurality of pre-defined and customizable messages therefore there will be a plurality of templates).

Sharma (Section 0020 lines 3 – 5) and Sauer (Section 0020, the fact that the mobile phone has SMS capability means that it is a digital phone) both teach a digital wireless phone thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to use SMS templates taught in Sauer in the mobile phone in Sharma for the purpose of enabling said mobile phone to participate in a communication even when said mobile phone is not active thus allowing a user of said mobile phone to receive important information without having to turn said mobile phone on.

9. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sharma (US 2002/0151334 A1) in view of Kariya (US 6,169,897 B1).

Regarding Claim 5, Sharma teaches all of the claimed limitations recited in Claim

1. Sharma further teaches a mobile telecommunications device (Figure 1).

Sharma does not teach a location-based services database and a list of landmarks being stored in memory.

Kariya teaches a location-based services database (Column 1 lines 33 – 37, Column 4 lines 5 – 13, Column 4 lines 28 – 47, the location-based services database is the table of local URLs in conjunction with area identifiers, each URL is related to a specific location, local map information includes landmarks) and a list of landmarks being stored in memory (Column 1 lines 33 – 37, Column 4 lines 5 – 13, Column 4 lines 28 – 47, the location-based services database is the table of local URLs in conjunction with area identifiers, each URL is related to a specific location, local map information includes landmarks).

Sharma (Section 0020 lines 3 – 5) and Kariya (Column 4 lines 64 – 67, the fact that the terminal allows access to internet content means that it is digital) both teach a wireless digital terminal thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the location-based URL method taught above in Kariya in the wireless digital terminal of Sharma for the purpose of creating an enhanced wireless terminal with additional features thus allowing a mobile subscriber to visit a locale and have access to local information resources about said locale as well as the surrounding area.

Regarding Claim 6, Sharma teaches all of the claimed limitations recited in Claim 1. Sharma further teaches a mobile telecommunications device (Figure 1).

Sharma does not teach a device that is WAP enabled and a list of URLs.

Kariya teaches a device that is WAP enabled (Column 4 lines 5 – 13, Column 4 lines 28 – 47, Column 4 lines 64 – 67, the fact that the terminal receives URLs and can access the WWW means that it is WAP enabled) and a list of URLs (Column 4 lines 5 – 13).

Sharma (Section 0020 lines 3 – 5) and Kariya (Column 4 lines 64 – 67, the fact that the terminal allows access to internet content means that it is digital) both teach a wireless digital terminal thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the location-based URL method taught above in Kariya in the wireless digital terminal of Sharma for the purpose of creating an enhanced wireless terminal with additional features thus allowing a mobile subscriber to visit a locale and have access to local information resources about said locale as well as the surrounding area.

10. Claims 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sharma (US 2002/0151334 A1) in view of Graham et al. (US 2003/0060240 A1).

Regarding Claim 7, Sharma teaches all of the claimed limitations recited in Claim 1. Sharma does not teach a database of images.

Graham teaches a database of images (Section 0060, lines 4 – 7).

Sharma and Graham (Figure 5) both teach hand held wireless devices with a limited keyboard thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the images taught in Graham in the hand held wireless device of Sharma for the purpose of allowing a mobile subscriber to

communicate with other subscribers in a non-verbal manner in an efficient and friendly manner under the context of limited input keys.

11. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sharma (US 2002/0151334 A1) in view of Thiriet (US 6,650,892 B1).

Regarding Claim 8, Sharma teaches all of the claimed limitations recited in Claim

1. Sharma does not teach a list of games.

Thiriet teaches a list of games (Column 3 lines 33 – 46).

Sharma (Section 0021 lines 13 – 16) and Thiriet (Column 1 lines 48 – 50) both teach a mobile phone with a SIM thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the list of games taught by Thiriet in the SIM of the mobile phone of Sharma for the purpose of creating a mobile phone with an additional capability other than telephony thus creating an enhanced and more versatile mobile phone.

### ***Conclusion***

12. Any inquiry concerning this communication should be directed to Raymond S. Dean at telephone number (703) 305-8998.

If attempts to reach examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung, can be reached at (703) 308-7745. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Application/Control Number: 10/023,700  
Art Unit: 2684

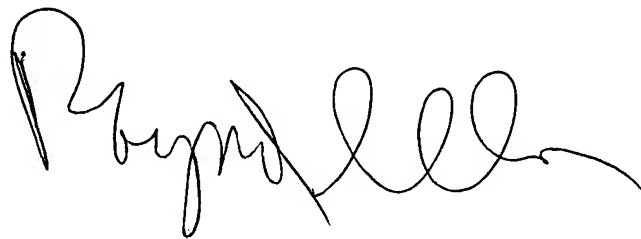
Page 12

Washington, D.C. 20231

Or faxed to:

(703) 872-9314 (for Technology center 2600 only)

Hand – delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist). Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377

A large, stylized handwritten signature in black ink, appearing to read "Raymond Lee".

**NAY MAUNG**  
**SUPERVISORY PATENT EXAMINER**